



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/517,364	03/02/2000	B. Scott Fabre	SLA0153:FCO	5185
26790	7590	01/04/2005	EXAMINER	
LAW OFFICE OF KAREN DANA OSTER, LLC			DONAGHUE, LARRY D	
PMB 1020				
15450 SW BOONES FERRY ROAD #9			ART UNIT	PAPER NUMBER
LAKE OSWEGO, OR 97035			2154	

DATE MAILED: 01/04/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application N .	Applicant(s)
	09/517,364	FABRE, B. SCOTT
	Examiner	Art Unit
	Larry D Donaghue	2154

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 14 June 2004.
 2a) This action is FINAL. 2b) This action is non-final.
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-24 is/are pending in the application.
 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
 5) Claim(s) _____ is/are allowed.
 6) Claim(s) 1-24 is/are rejected.
 7) Claim(s) _____ is/are objected to.
 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____ |

Art Unit: 2154

1. Claims 1-24 are presented for examination.

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claim 5 recites the limitation "specifically associated with" in step (a). There is insufficient antecedent basis for this limitation in the claim.

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1,2,3,6, 9,10,12,13, 21-23 are rejected under 35 U.S.C. 102(e) as being anticipated by Stevenson et al. 6,819,455.

Stevenson et al. taught the invention (claim 1,2 and 21) as claimed including a method for executing a request to print said "print portion" (col. 3, lines 26-35); generating a "print portion" uniqueness identifier in a host computer, said "print portion" uniqueness identifier specifically referring to and for identifying said "print portion" (col. 3, lines 36-50); comparing said "print portion" uniqueness identifier to a list of

Art Unit: 2154

uniqueness identifiers stored in memory (col. 1, lines 62-67, col. 3, lines 52-64); printing said "print portion" using previously rendered data stored in a memory location referenced by said list of uniqueness identifiers if said "print portion" uniqueness identifier is found in said list of uniqueness identifiers (col. 3, lines 52-64); and storing said "print portion" uniqueness identifier and a reference to data stored in memory pertaining to said "print portion" in said list of uniqueness identifiers if said "print portion" uniqueness identifier is not found in said list of uniqueness identifiers (col. 4, lines 12-25).

6. As to claim 3, Stevenson et al. taught printing said "print portion" printing an entire print job (col. 3, lines 52-64).

7. As to claim 6, Stevenson et al. taught performing an efficiency check (col. 4, lines 51-64). Determining that the proper files is used improves the overall efficiency of the system.

8. As to claims 9, 12, and 22, Stevenson et al. taught comparing said "print portion" uniqueness identifier to a list of uniqueness identifiers stored in memory further comprising the step of comparing said "print portion" uniqueness identifier to a list of uniqueness identifiers stored in memory in a printer (col. 3, lines 37-50).

9. As to claim 10, 13, and 23, Stevenson et al. taught transferring said "print portion" uniqueness identifier from said host computer to said printer (col. 3, lines 37-50).

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Art Unit: 2154

11. Claims 4, 5, 7, 8, 11, 14, 15-20, and 24 rejected under 35 U.S.C. 103(a) as being unpatentable over Stevenson et al. (6,819,455) as applied to claims 1,2,3,6, 9,10, 12,13, 21-23 above, and further in view of Mastie et al. (6,498,656).

12. As to claims 11, 14 and 24, Stevenson et al. did not teach transferring all or part of said "print portion" from said host computer to said printer if said "print portion" uniqueness identifier is not found in said list of uniqueness identifiers. Mastie et al. suggest the modification as it would reduce network traffic (col. 6, line 49- col. 7, line 11).

13. As to claims 4, 5, 7, 8, and 15-20, Stevenson et al. did not expressly teach taught printing said "print portion" printing a portion of an entire print job. Mastie et al. suggest the modification , segmenting print jobs into multiple files (col. 6, lines 49-57).

14. Claims 5 and 7 are multiple file version of claims 1,2, and 21 are rejected for the reason set forth in the rejections set forth in the rejection of claims 4 and 1,2, and 21.

15. Claim 8 is multiple file version of claim 6 and is rejected for the reason set forth in the rejections set forth in the rejection of claims 4 and 6.

16. Claims 15 and 18 are multiple file version of claims 9, 12 and 22 and are rejected for the reason set forth in the rejections set forth in the rejection of claims 4 and 9,12 and 22.

17. Claims 16 and 19 are multiple file version of claims 10, 13 and 23 and are rejected for the reason set forth in the rejections set forth in the rejection of claims 4 and 10,13 and 23.

18. Claims 16 and 20 are multiple file version of claims 11, 14 and 24 and are rejected for the reason set forth in the rejections set forth in the rejection of claims 4 and 11,13 and 24.

Art Unit: 2154

19. Applicant's arguments with respect to claims 1-24 have been considered but are moot in view of the new ground(s) of rejection.

20. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Mastie et al. 6,373,585

Mastie et al. 6,515,756

Mastie et al. 6,145,031

Speed 5,592,593

21. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

Art Unit: 2154

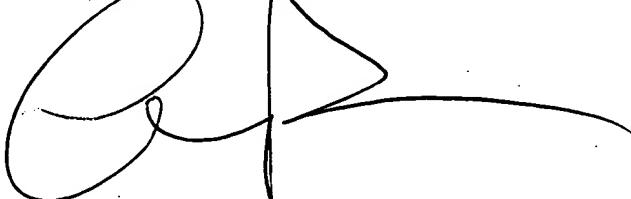
the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

22. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Larry D Donaghue whose telephone number is 571-272-3962. The examiner can normally be reached on M-F 8:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Follansbee can be reached on 571-272-3964. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

LARRY D. DONAGHUE
PRIMARY EXAMINER

A handwritten signature in black ink, appearing to read "LARRY D. DONAGHUE". Below the name, the words "PRIMARY EXAMINER" are written in capital letters. The signature is fluid and cursive, with a large, stylized "D" and "A".